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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/579,808	05/16/2006	Jean-Marie Bernard	0076144-000009	5954
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EXAMINER NILAND, PATRICK DENNIS				
ART UNIT		PAPER NUMBER		
1796				
NOTIFICATION DATE		DELIVERY MODE		
03/02/2010		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ADIPFDD@bipc.com  
offserv@bipc.com

### Office Action Summary

**Application No.**

10/579,808

**Applicant(s)**

BERNARD ET AL.

**Examiner**

Patrick D. Niland

**Art Unit**

1796

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 August 2009 and 23 September 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 20-23 and 25-50 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 35-37, 49 and 50 is/are allowed.
- 6) ☒ Claim(s) 20-23, 25-34, and 38-48 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-544)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/23/09 has been entered.

The amendment of 8/24/09 and 9/23/09 has been entered. Claims 20-23 and 25-50 are pending.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 20-23, 25-34, and 38-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. No. 3903052 Wagner et al..

Wagner discloses a composition containing the instantly claimed polyisocyanate compositions at column 1, lines 5-70 and column 2, lines 1-31, particularly the formula of columns 1 and 2, lines 15-30 in which B is chosen such that A is chosen from the diamine of column 2, lines 15-16, the subscripts n, p, and c are chosen so as to give the instantly claimed number of aminoalkylsilane units and diamino units from the values of column 2, lines 1-7, wherein the carbamate, i.e. urethane, groups and biuret groups of the reference meet the instantly claimed groups which derive from isocyanate functional groups as well as in which the terminal group Q is a diamine and/or in which Q' contains an isocyanate group. It is understood that such mixtures of polymeric molecules contain molecules that vary in molecular weight as evidenced

by average molecular weight, functionality as evidenced by average functionalities of polymers, and monomer sequencing. The composition of the patentee will therefore necessarily have the instantly claimed at least two distinct compounds. Molecules outside the scope of those claimed are encompassed by "comprising". The patentee does not specify the instantly claimed parameters only. It would have been obvious to one of ordinary skill in the art to use the compounds of Wagner et al. having the instantly claimed parameters because they are encompassed by Wagner and would have been expected to give compositions having the properties described by Wagner. Based on the viscosities of column 14, lines 15-20, the compositions of the patentee are expected to have viscosities of the instant claim 32.

Where P is three, the biuret comprises 3 alkoxysilanes, which meets the instantly claimed true biuret requirement c of the instant claims. The rationale to use this biuret of the cited prior art is that it is encompassed by the cited prior art, as discussed above and therefore expected to give the properties of the biurets of the cited prior art. The applicant has demonstrated no unexpected results in a manner commensurate in scope with the instant claims and the cited prior art stemming from the instantly claimed limitations that are a subset of those of the cited prior art. The argument that Wagner does not teach all of the instantly claimed limitations is not persuasive. The biuret group of the cited prior art is a "true" biuret. As stated above, where P is 3, it will have the 3 alkoxysilane functional groups of the instantly claimed option c of the instant claim 20. The argument that the aminoalkylsilane of Wagner is not an aminoalkylsilane unit as required of the instant claims but rather is an alkoxysilane group is not correct. See the instant claim 25 noting that X may be O and note the alkyl group R' of Wagner. Also note that n of the instant claim 25 may be 3 indicating that the "alkyl" really is the alkylene group of the instantly

claimed aminoalkylsilane. The reasonable expectation of success is the full disclosure of Wagner coupled with the above discussion.

The instant claim requirement of “wherein said isocyanate unit(s) and said alkoxyisilane group(s) are attached to the same biuret” is met because the isocyanate unit(s) and said alkoxyisilane group(s) are attached to the same biuret in the prior art compounds noted above. The instant claims do not specify how the attachment is to be done specifically. The attachment means of the patentee meets the requirement of the instant claims, of which the broad language encompasses any means of attachment of the isocyanate unit(s) and alkoxyisilane group(s) are attached to the same biuret. The applicant’s argument “When p is three, the above formula would have three biuret groups each having one alkoxyisilane, not one biuret group having three alkoxyisilane units, as required by requirement c of the instant claims.” is not commensurate in scope with the instant claims. The instant claims do not require “one biuret group having three alkoxyisilane units”, as argued. The instant claims encompass the biuret having three alkoxyisilane groups wherein said isocyanate unit(s) and said alkoxyisilane group(s) are attached to the same biuret but do not specify the means for attachment to the same biuret. The prior art clearly has three alkoxyisilane groups attached to the same biuret because it is a single molecule and therefore everything in it is somehow attached to a single biuret therein. The claim language and the argument of the applicant do not coincide in scope. Arguments regarding obviousness are not persuasive for the same reasons. The above rejection does not make the obviousness statements regarding the newly recited claim language argued. The above stated rationales for obviousness meet the requirements of *Graham v. Deere* and the Supreme Court’s “KSR” decision. See MPEP 2141-2144.

The applicant's arguments have been fully considered but are not persuasive for the above reasons. This rejection is therefore maintained.

4. Claims 35-37 and 49-50 are allowable over the prior art considered. The prior art does not disclose these claimed inventions nor provide rationale to modify the prior art disclosures into these inventions.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick D. Niland whose telephone number is 571-272-1121. The examiner can normally be reached on Monday to Friday from 10 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu, can be reached on 571-272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Patrick D Niland/  
Primary Examiner,  
Art Unit 1796